REMARKS

Claims 1-33 are pending in the Application. Claim 33 has been added. No new matter has been added. Entry of the amendment is respectfully requested. Reconsideration is respectfully requested.

Formal Drawings

A Request to Amend Drawings, four marked sheets of drawings, and thirty-one (31) sheets of formal drawings were filed in Applicants' response of August 2, 2001. However, the Action includes a PTO-948 referring to the originally filed drawings of November 17, 1998. Applicants request confirmation of their formal drawings filed on August 2, 2001. Thus, Applicants request a PTO-948 indicating that the drawings filed on August 2, 2001 are approved by the Office Draftsperson.

The 35 U.S.C. § 103 Rejections

Applicants' remarks concerning the claim rejections in no way waive their rights to have the rejections relying on the applied references stricken for the reasons presented herein.

Neither Davis nor Bator Constitute prior art

Claims 1-32 were rejected under 35 U.S.C. § 103(a) as obvious over Davis et al. (US 6,105,008) ("Davis") in view of Bator et al. (US 5,826,246) ("Bator"). These rejections are respectfully traversed.

Davis has a filing date of April 30, 1998. Davis also apparently claims priority as a continuation-in-part of U.S. application 08/951,614 filed October 16, 1997.

Bator has a filing date of December 31, 1996.

However, the present invention claims the benefit of the November 27, 1996 filing date of provisional application 60/031,956. Applicants' originally filed transmittal papers of November 17, 1998 included an amendment inserting their claim for priority into the Specification. Furthermore, the official filing receipt shows Applicants' claim for priority. Thus, this Application meets the conditions for claiming priority to the date of November 27, 1996. It follows that neither Davis nor Bator constitute prior art pursuant to said priority date. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejections should be withdrawn.

The Legal Standard

Before a claim may be rejected on the basis of obviousness, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. If the Office does not produce a *prima facie* case, then the Applicants are under no obligation to submit evidence of nonobviousness. MPEP § 2142.

Absent a showing of a teaching, suggestion, or motivation to produce a claimed combination, an obviousness rejection is not proper. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The teaching, suggestion, or motivation to combine the features in a prior art reference must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

It is respectfully submitted that the Action does not meet these burdens.

The Claims Are Not Obvious Over
Davis in view of Bator

Claims 1-32 were rejected under 35 U.S.C. § 103(a) as obvious over Davis in view of Bator. These rejections are respectfully traversed.

As previously discussed, neither Davis nor Bator constitute prior art. Nevertheless, even if it were somehow possible for both Davis and Bator to constitute prior art, the Office still has not presented a *prima facie* showing of obviousness, as discussed in more detail herein.

For brevity the Applicants have not necessarily presented all the reasons as to why the applied references do not render the claims obvious. Applicants reserve the right to later present additional reasons. Nevertheless, Applicants' arguments show that the applied references do not disclose or suggest all of the features, relationships, and/or steps of the claimed invention. Hence, Applicants' claims patentably distinguish over the applied references. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejections should be withdrawn.

Claim 1

Neither Davis nor Bator, taken alone or in combination, disclose or suggest the features and relationships that are specifically recited in the claim. The Action is devoid of any such

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teaching, suggestion, or motivation for combining the references. Neither Davis nor Bator teach or suggest software executable in a computer of an automated transaction machine, such that the software includes a first object operative to control an input device, and a second object which is operative to control a sheet dispenser, wherein the first object operates the input device and the second object operates the sheet dispenser responsive to transaction device instructions accessed at an HTTP address. Furthermore, neither Davis nor Bator teach or suggest that the software further includes a transaction data object, such that the transaction data object is in operative connection with the first object and second object and is operative to store therein data representative of both user inputs to the input device and the dispense of sheets by the dispenser.

Davis is only concerned with a smart card, not with operating devices of an automated transaction machine, especially operating transaction machine devices <u>responsive</u> to transaction device instructions accessed at an HTTP address. Nor does Davis operate a sheet dispenser. Even the Action admits (page 4, last paragraph) that Davis does not teach or suggest a sheet dispenser. Furthermore, even if it were somehow possible for Davis to have included a sheet dispenser, there still would be no link between the sheet dispenser and operation of the sheet dispenser responsive to a transaction device instruction accessed at an HTTP address.

The Action, as best understood, alleges that Davis teaches "software that operates peripheral devices responsive to instructions received" at Figures 11A-13, 16-18D and at Figures 4-11D, 16-18D, col. 24 lines 13-27, and col. 28 lines 20-57 for the recited feature. The Applicants respectfully disagree. The cited sections of Davis do not teach or suggest the recited features and relationships.

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Bator cannot alleviate the deficiencies in Davis as it does not disclose or suggest the recited features which Davis lacks. Nor has the Action shown that Bator is associated with an HTTP address. Nor does Bator teach or suggest operating a sheet dispenser responsive to a transaction device instruction accessed at an HTTP address. Even if it were somehow possible for Davis to be modified by Bator to include a sheet dispenser, there would still be no teaching of operating the sheet dispenser responsive to a transaction device instruction accessed at an HTTP address. Thus, it would not have been obvious to have combined the teachings of Davis nor Bator to have produced the recited invention.

Davis also does not teach or suggest that the recited software includes a <u>transaction data object</u>, wherein the transaction data object is in operative connection with the first object and second object and is operative to store therein data representative of <u>both</u> user inputs to the input device and the dispense of sheets by the sheet dispenser. An exemplary embodiment of the invention involving a transaction data object (104) may be found at Specification page 26, lines 1-12, and shown schematically in Figure 9. Further support for a transaction data object may be found at Specification page 29, lines 18-19; page 40, lines 8-11; page 62, lines 10-12; page 63, lines 13-14; page 64, lines 5-15; page 65, lines 5-18; page 66, lines 1-2; and page 74, lines 9-12 and 20-21.

The Action, as best understood, alleges that Davis teaches "storing transaction data" at col. 12 lines 26-42; col. 13, lines 1-63; and col. 28, lines 20-25. The Action also alleges that Davis teaches "memory that stores transaction data" at Figures 4, 19; col. 4, lines 46-56; col. 12, lines 53-67; col. 14, lines 40-50; and col. 28, lines 20-57. The Applicants respectfully disagree. The cited sections of Davis do not teach or suggest the recited features and relationships.

Davis' system does not include use of a <u>transaction data object</u> in software executable in a computer of an automated transaction machine. There is no indication in Davis of a transaction data object in operative connection with a first software object and a second software object, especially where the first object can operate to control an input device (of the automated transaction machine) and the second object can operate to control a sheet dispenser (of the automated transaction machine) responsive to accessed transaction device instructions. Nor is there any indication in Davis of a transaction data object being operative to store therein data representative of both user inputs to the input device and the dispense of sheets by the dispenser. Davis does not store transaction data in memory as data in an object in software.

The Action admits (page 4, last paragraph) that Davis does not teach or suggest a sheet dispenser. There is good reason why Davis does not have a sheet dispenser. Davis desires to use a smart card with a client terminal including a "portable device such as a laptop computer, a cellular telephone, or any variety of personal digital assistant (PDA)" (col. 8, lines 17-19). Thus, Davis teaches away from sheet dispensing. Davis has no need of a sheet dispenser. Therefore, why would Davis' be concerned with a sheet dispenser? Furthermore, why would Davis' be concerned with storing data representative of the dispense of sheets by a sheet dispenser? Thus, it would not have been obvious to have modified Davis to have included a sheet dispenser or a transaction data object operative to store therein data representative of a dispense of sheets by the sheet dispenser.

Furthermore, the addition of a sheet dispenser in Davis would destroy the explicitly disclosed and desired utility and operability of the Davis teaching. That is, any modification of

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Davis to have included a sheet dispenser would render the reference inoperable for its intended and disclosed purpose.

An obviousness rejection cannot be based on a combination of features if making the combination would result in destroying the utility or advantage of the device shown in the prior art reference. Note *In re Fine*, 5 USPQ2d 1598-99 (Fed. Cir. 1988). Therefore, it would not have been obvious to have modified Davis to have produced the recited invention.

There is no teaching or suggestion in Bator of a transaction data object. Nor is there any teaching or suggestion in Bator of a transaction data object being operative to store therein data representative of both user inputs to an input device and the dispense of sheets by a sheet dispenser. Again, Bator cannot alleviate the deficiencies in Davis as it does not disclose or suggest the recited features which are lacking in Davis. Even if it were somehow possible (which it isn't) for Davis to be modified by Bator to include a sheet dispenser, there would still be no teaching of a transaction data object, or of storing data representative of both user inputs to an input device and the dispense of sheets by the sheet dispenser. Thus, it would not have been obvious to have combined the teachings of Davis nor Bator to have produced the recited invention.

The Action is silent as to how Davis could be modified by Bator to include the recited features and relationships. It is unclear how Davis' portable devices could be modified to include either a sheet dispenser or Bator's postage meter arrangement having a weighing platform, meter, and vault. Again, it would not have been obvious to have modified Davis with the teachings of Bator to have produced the recited invention. The Action is devoid of any such teaching, suggestion, or motivation for combining features of the references.

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The attempts to modify Davis are clearly attempts at hindsight reconstruction of Applicants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 22 USPQ2d 1780 (Fed. Cir. 1992). The rejection, which lacks the necessary evidence and rationale, is based on knowledge gleaned only from Applicants' disclosure.

Applicants respectfully traverse the rejection and require the Office to support a rejection of the features and relationships recited in pending claim 1 with citation to relevant prior art as is required by MPEP § 2143.03. The Office bears the burden of establishing that all the recited features of the claim are known in the prior art. Applicants respectfully submit that the Office has not met this burden. The recited invention would not have been obvious to one having ordinary skill in the art.

The Office has not presented a *prima facie* showing of obviousness. If the Office does not produce a *prima facie* case, which is the current situation, then Applicants are under no obligation to submit evidence of nonobviousness. MPEP § 2142.

Nevertheless, Applicants have shown that neither Davis nor Bator disclose or suggest the recited features and relationships. Nor would it have been obvious to have combined the teachings of Davis and Bator. Nor would it have been obvious to have combined the teachings of Davis and Bator to have produced Applicants' recited invention. Furthermore, Applicants have also shown that even if it were somehow possible for Davis to have included the teachings of Bator, the modified Davis would still lack features and relationships recited in claim 1. It follows that neither Davis nor Bator, taken alone or in combination, disclose or suggest the

features and relationships that are specifically recited in the claim. Thus, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection should be withdrawn.

Claim 11

Method claim 11 recites some subject matter similar to subject matter in apparatus claim 1. Applicants' remarks in support of the patentability of claim 1 are incorporated by reference as if fully rewritten herein. Thus, it is respectfully submitted that claim 11 also patentably distinguishes over the references.

As previously discussed, neither Davis nor Bator, taken alone or in combination, disclose or suggest operating an automated transaction machine device responsive to device operating instructions accessed at an HTTP address by a computer in the machine. Furthermore, neither Davis nor Bator, taken alone or in combination, disclose or suggest storing data, generated with the device responsive to operation of the device, in a transaction data object in a memory in operative connection with the computer. Where does either Davis or Bator specifically teach or suggest operating an automated transaction machine device responsive to device operating instructions accessed by a computer in the machine at an HTTP address? Where does either Davis or Bator specifically teach or suggest generating data with the device, responsive to operation of the device? Where does either Davis or Bator specifically teach or suggest storing the generated data in a transaction data object in a memory in operative connection with the computer? Again, the Office bears the burden of establishing that all the recited features of the claim are known in the prior art. Applicants respectfully submit that the Office has not met this burden. Thus, the Office has not presented a *prima facie* showing of obviousness.

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Claim 18

Applicants' remarks in support of the patentability of claims 1 and 11 are incorporated by reference as if fully rewritten herein. Neither Davis nor Bator, taken alone or in combination, disclose or suggest storing data corresponding to identifying data in a transaction data object in software operating in a computer in operative connection with an automated transaction machine. Additionally, neither Davis nor Bator, taken alone or in combination, disclose or suggest storing data corresponding to operation of a transaction function device in the transaction data object. It follows that neither reference discloses or suggests storing <u>both</u> data corresponding to identifying data and data corresponding to operation of a transaction function device in a transaction data object. Nor is there any teaching or suggestion in Davis or Bator, taken alone or in combination, of conducting a transaction including accessing the data in the transaction data object. The Office has not presented a *prima facie* showing of obviousness. Nor would it have been obvious to have combined the teachings of Davis and Bator to have produced the recited invention.

Claim 30

Applicants' remarks in support of the patentability of claims 1, 11, and 18 are incorporated by reference as if fully rewritten herein. Neither Davis nor Bator, taken alone or in combination, disclose or suggest an automated transaction machine computer adapted to operate responsive to at least one mark up language document to cause at least one sheet to be dispensed from the machine. Nor is there any teaching or suggestion in Davis or Bator, taken alone or in combination, of the computer being operative to store in a memory data representative of the dispense of the at least one sheet.

As previously discussed, Davis teaches away from sheet dispensing. Thus, it would not have been obvious to have modified Davis to have included a sheet dispenser, or to have included the capability to store in a memory data representative of the dispense of at least one sheet by the sheet dispenser.

It follows that the Office has not presented a *prima facie* showing of obviousness. It would not have been obvious to have combined the teachings of Davis and Bator to have produced the recited invention. Thus, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection should be withdrawn.

The Dependent Claims

Each of the dependent claims depends directly or indirectly from an independent claim. The independent claims have been previously shown to be allowable. It is asserted that the dependent claims are allowable on the same basis.

Furthermore, each of the dependent claims additionally recite specific features, relationships, and/or steps that patentably distinguish the claimed invention over the applied art. Neither Davis nor Bator, taken alone or in combination, disclose or suggest the features, relationships, and/or steps that are specifically recited in the dependent claims. Thus, it is respectfully submitted that the dependent claims are further allowable due to the recitation of such additional features, relationships, and/or steps.

For example, with regard to claims 19, 26, 29, and 32, as previously discussed, it would not have been obvious to have modified Davis to have included a sheet dispenser, especially a currency note dispenser. Furthermore, the Action has not shown that Bator's postage meter

operation is not independent of any ATM operation involving a cash dispensing transaction. Thus, both Davis and Bator appear to be non analogous art. Further, neither Davis nor Bator, taken alone or in combination, disclose or suggest the features, relationships, and/or steps that are specifically recited in these dependent claims.

Fees For Additional Claims

Please charge the fee associated with the submission of one additional independent claim and one claim in excess of twenty claims ($102) and any other fee due to deposit account 09-0428.

In the Claims

18. (once amended) A method comprising [the steps of]:

      (a)   accepting identifying data from a user of an automated banking machine;

      (b)   storing data corresponding to the identifying data in a transaction data object in software operating in a first computer in operative connection with the machine;

      (c)   conducting a first transaction responsive to [a] <u>at least one</u> user input to the machine, wherein conducting the first transaction includes accessing the data in the transaction data object<u>;</u>

      <u>(d)</u>   <u>storing data corresponding to operation of a transaction function device in the transaction data object</u>.

19. (once amended) The method according to claim 18 wherein [step (c) includes operating a first transaction function device in the machine, and further comprising the step of:

(d)   storing data corresponding to operation of the transaction function device in the transaction data object] the transaction function device comprises a currency note dispenser, and (d) includes storing data corresponding to operation of the currency note dispenser in the transaction data object.

20. (once amended) The method according to claim 18 and further comprising [the step of]:

[(d)] (e)   conducting a second transaction responsive to [a] at least one user input to the machine, wherein conducting the second transaction includes accessing the data in the transaction data object.

21. (once amended) The method according to claim 18 and further comprising [the step of]:

[(d)] (e)   accounting for the first transaction by the user, including passing the transaction data object from the first computer.

22. (once amended) The method according to claim 18 and further comprising [the step of]:
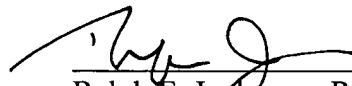
[(d)] (e)   producing a printed record corresponding to the first transaction with the machine, including accessing the data in the transaction data object and producing indicia in the printed record corresponding to at least a portion of the data stored in the transaction data object.

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Conclusion

Each of Applicants' pending claims specifically recite features, relationships, and/or steps that are neither disclosed nor suggested in any of the applied art. Furthermore, the applied prior art is devoid of any such teaching, suggestion, or motivation for combining features of the applied art so as to produce Applicants' invention. The present application is entitled to a priority date that is earlier than any of the applied art. Allowance of all of Applicants' pending claims is therefore respectfully requested.

The undersigned will be happy to discuss any aspect of the Application by telephone at the Examiner's convenience.

Respectfully submitted,

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